

ESTTA Tracking number: **ESTTA234337**

Filing date: **09/03/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91168756
Party	Plaintiff Federation Des Industries de la Parfumerie
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Date	09/03/2008
Attachments	Reply to Motion to Compel 09.03.08.pdf (9 pages)(855159 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Consolidated Opposition
Mark: L'BEL PARIS

FEDERATION DES INDUSTRIES DE LA
PARFUMERIE,

Opposer,

v.

EBEL INTERNATIONAL LIMITED,

Applicant.

Opposition No. 91168756

**REPLY TO APPLICANT'S OPPOSITION TO
OPPOSER'S MOTION TO COMPEL CERTAIN DISCOVERY**

On July 28, 2008, Opposer, the Federation des Industries de la Parfumerie ("Opposer" or "FDI") filed its Motion to Compel ("Motion") with the Trademark Trial and Appeal Board ("the Board" or "TTAB") requesting that the Board compel Ebel International Limited ("Applicant" or "Ebel") to respond to Opposer's Interrogatory Nos. 9, 10(b)(ii) and 32, and Document Request Nos. 30 and 31. Opposer's Motion specifically stated that it had made numerous good faith attempts to resolve the outstanding discovery issues with Applicant. The Motion made of record letters from Opposer to Applicant dated May 3, 2007, May 24, 2007, November 13, 2007 and July 11, 2008 (see Motion Exhibit 2).

Ebel's Opposition to Opposer's Motion to Compel ("Opposition"), filed on August 18, 2008, requests the Board to deny the Motion to Compel on the grounds (a) that Opposer failed to comply with the requirement that it make a good faith effort to resolve the outstanding issues and

(b) that the Motion was untimely.¹ Given that Opposer has made repeated attempts to obtain the information requested in the three interrogatories and two document requests that are the subject of this dispute, coupled with the fact that Applicant has repeatedly avoided providing the information, Applicant's attempts to portray Opposer as being dilatory and/or in non-compliance with the requirements specified by 37 C.F.R. 2.120(e) are somewhat disingenuous.

REPLY

The Motion to Compel concerns the fact that Applicant has consistently refused to provide Opposer with the following information:

- the sales in dollars and units by Applicant for all goods sold under the L'BEL PARIS trademark since the date of first use to date, by month (Interrogatory No. 9);
- the amount of money in dollars expended for advertising and promotion of goods bearing the L'BEL PARIS trademark since the date of first use, by month or other relevant period (Interrogatory No. 10(b)(ii)); and
- the sales in dollars and units by Applicant for all goods sold under any other mark besides L'BEL PARIS, as well as documents relating thereto (Interrogatory No. 32; Document Requests 30-31).

Rather than providing full and complete responses to these Interrogatories and Document Requests, Applicant has withheld the requested information on the ground that it is either confidential or irrelevant. (See Motion Exhibit 1 - Applicant's Answers to Opposer's First Set of Interrogatories Nos. 9 and 10(b)(ii) dated September 1, 2006; Applicant's Answers to Opposer's Third Set of Interrogatories No. 32 dated August 6, 2007; Applicant's Answers to Opposer's Second Set of Requests for Production of Documents Nos. 30-31 dated August 6, 2007; and

¹ Applicant's FACTS contain a disputable fact (whether Ebel has a "family" of L'BEL PARIS marks) and an erroneous fact (the opposition is based on Section 2(a) deceptiveness, as well as Section 2(e)(3) geographic deceptive misdescriptiveness).

Motion Exhibit 2 - Applicant's letters dated June 8, 2007; December 18, 2007; and July 18, 2008).

Applicant seeks to paint Opposer as being dilatory. However, throughout these proceedings Opposer has not only timely advised Applicant why it believed its responses were deficient, but it has also sought to resolve the issue in a manner that would avoid the need for filing a Motion to Compel. Opposer has sent four follow up letters – three of them explicitly stating that the letters were good faith efforts to resolve the issues. These efforts go far beyond the “good faith” requirement mandated by 37 C.F.R. 2.120(e).

It is respectfully submitted that given Applicant's repetitive and identical responses to these specific interrogatories and document requests, an additional telephonic “meet and confer” would not have resolved the issue.

Chronology of Discovery

Ebel has provided a brief summary of the discovery history in this case and in so doing has summarily dismissed the numerous good faith efforts Opposer undertook to work with Applicant to resolve the outstanding disputes. Opposer requests the opportunity to clarify the facts.

On July 28, 2006, FDI served Ebel with its First Set of Interrogatories (Interrogatory Nos. 1-17, see Motion Exhibit 1) and Document Requests (Request Nos. 1-29). On September 1, 2006, Applicant provided written responses (see Motion Exhibit 1). With respect to Interrogatory No. 9 and 10(b)(ii), Applicant stated:

Applicant incorporates its General Objections as if set forth fully herein. Applicant further objects to this interrogatory on the grounds it is vague, ambiguous, overbroad, unduly burdensome, oppressive, and that it seeks information which is neither relevant to the subject matter of the pending action, nor reasonably calculated to lead to the discovery of relevant or admissible evidence. Applicant further objects on the ground that [] this interrogatory seeks the disclosure of confidential business information.

(See Motion Exhibit 1).

Following Applicant's September 1, 2006 responses, the parties worked to resolve the issues relating to the Protective Order and on March 15, 2007 the parties entered into a Stipulated Protective Order. (See TTAB Prosecution History Doc #12). After the entry of the Protective Order, and well before the close of discovery, Opposer wrote Applicant on May 3, 2007 stating:

After review of Applicant's written responses and document production, we note that the responses are deficient in many respects. As an initial matter, we would like to know whether Applicant will be supplementing its responses and document production in light of the recently entered Stipulated Protective Order. In particular, Applicant objected to Interrogatory Nos. 1-6 and 8-11 on the ground that it "may seek the disclosure of confidential business information." In response to Document Request Nos. 1-13; 16-18; 21-24; and 27, Applicant objected on the same ground and stated that that "responsive documents containing confidential business information will only be produced upon entry of an acceptable protective order."

As discovery is set to close on June 11, 2007, please let us know by May 9, 2007 whether Applicant will supplement its discovery responses and document production, which responses will be supplemented and when we should expect the supplemental responses and documents. We will address the remaining deficiencies in more detail upon receipt of this information. In addition, please let us know when we should expect Applicant's privilege log.

(See May 3, 2007 letter from J. Choi to E. Brito at Motion Exhibit 2).

In response, on May 18, 2007, Applicant provided a second set of documents. Opposer reviewed the material, but given the fact that Applicant continued to rely on confidentiality with respect to Interrogatory Nos. 9 and 10(b)(ii), Opposer sent another letter in an attempt to resolve the outstanding issues. (See May 24, 2007 letter from J. Choi to E. Brito at Motion Exhibit 2).

Applicant responded by stating that:

Without waiving any of its objections, Ebel states that it objects to this request on the grounds it is vague, ambiguous, overbroad, unduly burdensome, oppressive, and that it seeks information which is

neither relevant to the subject matter of the pending action, nor reasonably calculated to lead to the discovery of relevant or admissible evidence.

(See June 8, 2007 letter from E. Brito to J. Choi at Motion Exhibit 2).

Thus, Opposer made two attempts to obtain the requested information from Applicant and Applicant objected both times.

On June 6, 2007, Opposer served Opposer's Second Set of Interrogatories (Interrogatory Nos. 18-30) and Opposer's Second Set of Requests for Admission (Request Nos. 5-34). On June 26, 2007, Opposer served Opposer's Second Set of Requests for Production of Documents and Things (Request Nos. 30-31), Opposer's Third Set of Interrogatories (Interrogatory Nos. 32-33) and Opposer's Third Set of Requests for Admission (Request Nos. 35-38). All relevant documents are made of record with Motion Exhibit 1.

Applicant responded to Opposer's June 6 requests as well as its June 26 requests on August 6, 2007. (See Motion Exhibit 1).

In the interim, the parties stipulated to and were granted three extensions for additional time for discovery. (See TTAB Prosecution History Doc #17-22). Opposer continued to make an effort to work with Ebel to resolve the outstanding Discovery disputes. Specifically on November 13, 2007, Opposer's counsel wrote Applicant's counsel to inquire about the deficiencies in Applicant's responses to Interrogatory Nos. 9, 10(b)(ii) and 32, and Document Request Nos. 30 and 31. Applicant's counsel responded on December 18, 2007, but did not provide the requested information. (See Motion Exhibit 2).

In February 2008, Ebel approached FDI to inquire whether there was a possibility of settlement. As a result, the parties filed two more extensions of time to accommodate for possible settlement negotiations. (See TTAB Prosecution History Doc #23-26).

In July 2008, Opposer's counsel requested Applicant's counsel for additional time for Opposer to respond to the possibility of settlement, Applicant chose not to agree to any further

extensions. As reflected in the correspondence between the parties dated November 13 and December 18, 2007, there were still outstanding discovery issues because Applicant had not responded to Document Request Nos. 5, 16, 26, 30 and 31; Interrogatory Nos. 9, 10(b)(ii), 19 and 32; and Requests for Admission Nos. 5, 6, 35 and 38). Thus, on July 11, 2008, Opposer made one more good faith attempt to resolve the dispute and wrote Applicant's counsel requesting that it provide full and complete responses to those discovery requests.

Applicant's counsel responded on July 18, 2008 (see Motion Exhibit 2). It complied with Opposer's requests with respect to Document Request Nos. 5, 16, 26; Interrogatory No. 19; and Requests for Admission Nos. 5, 6, 35 and 38. Thus, Applicant believed that Opposer's request was timely and chose to respond to almost all of the outstanding discovery issues but for the ones that are the subject of the Motion to Compel. To the extent that Applicant provided full and complete responses to Document Request Nos. 5, 16, 26; and Interrogatory No. 19; and Requests for Admission Nos. 5, 6, 35 and 38, but not Interrogatory Nos. 9, 10 (b)(ii), 32; and Document Request Nos. 30 and 31, it is somewhat hollow for Applicant to claim that Opposer has been either dilatory or not genuine in its efforts to resolve the matter in good faith. Despite all of Opposer's attempts to obtain the requested information, Applicant still refuses to provide the requested financial information regarding its sales and advertising.

Opposer Has Not Delayed the Filing of This Motion

37 C.F.R. 2.120(e) provides that a Motion to Compel must be filed prior to the commencement of Opposer's testimony period. Thus, Opposer's Motion is timely.

Applicant, however, argues that Opposer's time to file this motion has expired. (Opposition at 4). To the extent that Applicant has consistently avoided and evaded responding to the interrogatories and document requests that are the subject of this dispute but did respond to Document Request Nos. 5, 16, 26; and Interrogatory No. 19; and Requests for Admission Nos. 5, 6, 35 and 38, it is somewhat illogical for Applicant to claim that Opposer's time has expired.

Applicant's argument that the Motion fails because Opposer did not file its motion to compel "within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate" is unfounded. Indeed, the fact that Applicant provided long-overdue responsive documents to Opposer as late as July 18, 2008 – just 10 days before the Motion to Compel – serves to show that the parties were able to resolve additional disputes without the TTAB's intervention and that Opposer's efforts were not delayed.

Further, it is disingenuous given that during the course of this proceeding, the parties have jointly requested for and have been granted nine extensions of time to complete discovery (see TTAB Prosecution History Docket # 5, 6, 9, 10, 13-26). Indeed, the most recent joint request for extension in May 2008 was filed and granted by the TTAB because the parties had been contemplating settlement negotiations since February 2008.

In early July 2008, Opposer's counsel requested Applicant's counsel for an additional extension so that the parties could possibly evaluate settlement following the summer holidays. Applicant refused. Thus, it would have been premature if Opposer had filed this motion any earlier because there was a possibility – and there still is – that resources would have been wasted in light of potential settlement.

The Disputed Interrogatories and Document Requests are Relevant

Applicant seeks to avoid providing the sales and advertising information on the ground that this case involves issues relating to the geographic significance of a term rather than likelihood of confusion it is irrelevant. Applicant's focus and analysis of the statutory provisions relating to the registrability of geographic marks is too narrow.

As stated in the opposition, it is Opposer's premise that the presence of the word PARIS in Applicant's mark is a material factor to the sale of Ebel's beauty products. As Applicant stated in its Opposition papers, Ebel is committed to the "self-fulfillment and well being of

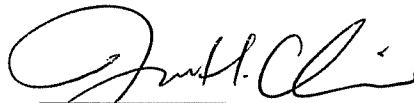
thousands of women in the countries where its product are sold.” Opposer seeks to obtain the financial data because it has a good faith belief that Ebel, who is based more than 400 miles from the city of Paris and has no other business association with the city of Paris, nonetheless chose to use and register a trademark with the word PARIS because in the minds of the American consumer PARIS is a code word for fashion, style, and beauty.

Moreover to the extent that the presence of the word PARIS enhances the image of the product, it also enhances Ebel’s ability to market, advertise, promote and sell its goods and thereby fulfill its commitment to the “self-fulfillment and well being of thousands of women in the countries where its product are sold.” However, the entire advertising campaign and all sales derived therefrom are based on deception because there is no association between the goods and Paris.

Conclusion

For the reasons set forth above and the reasons set forth in Opposer’s Motion, Opposer respectfully requests that the TTAB compel Applicant to provide the requested financial information regarding sales and advertising of goods sold by Applicant under its “Paris” and “non-Paris” marks.

Date: September 3, 2008
New York, New York

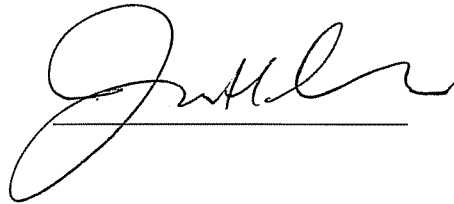

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CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of September 2008, I caused a true and correct copy of the foregoing REPLY TO APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL CERTAIN DISCOVERY to be served by email and first class mail, postage prepaid, upon:

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A handwritten signature in black ink, appearing to read 'Efrain Brito', is written over a horizontal line.